Claims 4-9, 12-13, 17, 20-24, 26-32 and 36 stand rejected under 35 U.S.C. 112, second paragraph.

These claims have been amended, as suggested by the Examiner, as in the parent case.

Claim 6 has been cancelled in the preliminary amendment filed June 17, 1999. Thus the objection to claim 6 is moot. Claim 10 has been amended to recite "said at least a portion". Claim 10 is now clear that applicant is referring to the same portion as in claim 1. Claim 11 has been amended to recite "said at least one layer". Claim 11 is now clear that this layer is the same as recited in claim 1.

Claims 1-2, 4-5, 7-9, 21-24, 26-28 and 55-63 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,413,874 in view of European Patent Application No. 0 486 711 A1.

This rejection is respectfully traversed.

The instant claims recite a process comprising electroplating an article, drying it by subjecting it to pulses of air, and depositing a coating on the dried article by physical vapor deposition. The '874 patent is deficient in disclosing, or even suggesting, subjecting the electroplated article to pulses of air to dry the articles. It is thus deficient in disclosing the heart of applicants' invention. Recognizing this deficiency of the '874 patent the Examiner uses the European patent application in an attempt to remedy this deficiency of the '874 patent. However, the European patent application is entirely deficient in disclosing a process wherein a PVD coating is applied on the electroplated article.

It is well settled patent law that the mere fact that references can be combined does not render the resultant

combination obvious unless the prior art also suggests the desirability of the combination. ACS Hospital Systems, Inc. v. Montefiore Hospital (CAFC 1984) 221 USPQ 929. What is there in either of these two cited references that suggests the desirability combining them? It is respectfully submitted that this combination is a result of hindsight reconstruction in view of applicants' disclosure. Such hindsight reconstruction is improper.

Claims 29-32 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Moysan '874 in view of EP '711 and further in view of Moysan '972 and U.S. Patent No. 4,029,556.

This rejection is respectfully traversed.

The only one of the four cited references which discloses drying electroplated surfaces is EP '711. Applicants are claiming a specific process. None of the cited references even comes close to disclosing such a process. As stated by the CCPA in In re Shaffer, (CCPA 1956) 108 USPQ 327, 328-329:

> It is too well settled for citation that references may be combined for the purpose of showing that a claim is unpatentable. However, they may not be combined indiscriminately, and to determine whether the combination of references is proper, the following criterion is often used: namely, whether the prior art suggests doing what an applicant has done. Furthermore, when references are combined to negate patentability, it should also be considered whether one skilled in the art with the references before him could have made the combination of elements claimed without the exercise of invention. The foregoing cases, in our opinion, stand for the proposition that it is not enough for a valid rejection to view the prior art in retrospect once an applicant's disclosure is known. The art applied should be viewed by itself to see if it fairly disclosed doing what an applicant has done. If

> the art did not do so, the references may have been improperly combined.

Here, it is respectfully submitted, the prior art has been viewed in retrospect in light of applicants' disclosure. The art applied viewed by itself did not disclose doing what applicants have done. Thus, it is respectfully submitted that this rejection is improper and should be withdrawn.

Claims 10-13, 18 and 20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Moysan '874 in view of EP '711 and further in view of Moysan '972 and U.S. Patent No. 5,558,759 (Pudem) and U.S. Patent No. 4,273,837 (Coll-Palagos).

This rejection is respectfully traversed.

It is respectfully suggested that this rejection, which employs five references, must fall of its own weight. The Examiner's rejection also violates the acknowledged standards of patentability. The rearrangement and distillation process the Examiner has used only renders applicants' invention obvious by the use of hindsight. As stated in Northern Engineering and Plastics Corp. v. Eddie et al, 210 USPQ 784, 787 (3rd Cir. 1981):

> We must also guard against the hindsight which renders every pure concept natural, intuitive, and "obvious" just because it is fundamentally simple.

With hindsight applicants' invention may appear simple. The mere fact that applicants' invention appears simple with the benefit of hindsight does not make it obvious at the time of the invention. Hindsight is insidious in that it uses applicant's own teaching against him. We must always be aware of this type of rejection.

See W.L. Gore & Associates v. Garlock Inc., 220 USPQ 303 (CAFC 1983).

Claims 14-17, 19 and 33-36 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Moysan '874 in view of Moysan '972, Monaco and further in view of U.S. Patent No. 5,922,478 (Welty).

This rejection is respectfully traversed.

It is a basic tenet of patent law that one must follow the teachings of the prior art as a whole in order to combine references within the framework of 35 U.S.C. 103. In re Wesslau, 147 USPQ 391 (CCPA 1965); Connell et al v. Sears Roebuck & Co., 220 USPQ 193 (CAFC 1983). The Examiner has violated this basic tenet in this rejection. The Examiner is taking the Moysan '874 reference and by hindsight is combining it with the secondary references using applicants' invention as a road map to find the desired traits the Examiner wants in different references and combining them in a way the Examiner wants to meet the limitations of the claim. However, apart from applicants' own disclosure, there is no apparent reason or desirability at the time the invention was made for a person of ordinary skill in the art to combine these four references together. There is no apparent reason, desirability or motivation to combine these four references absent applicants' disclosure and therefore the combination is improper.

Furthermore, none of these four references discloses pulsing air onto the electroplated article to dry the surface thereof.

Claims 1-2, 4-5, 7-24, 26-36 and 55-63 stand rejected under the judicially created doctrine of obviousness type double patenting over all the claims of U.S. Patent No. 5,879,532 in view of EP '711.

Enclosed is a Terminal Disclaimer over U.S. Patent No. 5,879,532. This Terminal Disclaimer obviates this rejection.

Claims 1-2, 4-5, 7-9, 21-24, 26-36 and 55-63 stand provisionally rejected as being unpatentable over the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-27 of copending Application Serial No. 09/264,361.

Enclosed is a Terminal Disclaimer over Application Serial No. 09/264,361. This Terminal Disclaimer is now believed to obviate this rejection.

Claims 1-2, 4-5, 7-24, 26-36 and 55-63 stand provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-5, 7-40 and 43-61 of copending Application Serial No. 09/239,581.

Enclosed is a Terminal Disclaimer over Application Serial No. 09/239,581. This Terminal Disclaimer is now believed to obviate this rejection.

In view of the foregoing this application is now believed to be in condition for allowance and action to such effect is respectfully solicited.

Respectfully submitted,

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Date 3-24-00